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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,039	02/15/2002	Jurgen Conrady	4070-63PUS	9323
7590	10/06/2003			EXAMINER HARPER, HOLLY R
Thomas Pontani Cohen Pontani Lieberman & Pavane 551 Fifth Avenue Suite 1210 New York, NY 10176			ART UNIT 2879	PAPER NUMBER
			DATE MAILED: 10/06/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b> 10/069,039	<b>Applicant(s)</b> CONRADY, JURGEN
<b>Examiner</b> Holly R. Harper	<b>Art Unit</b> 2879

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is FINAL.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-59 is/are pending in the application.  
 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.  
 5) Claim(s) 53-59 is/are allowed.  
 6) Claim(s) 31-42 and 52 is/are rejected.  
 7) Claim(s) 43-51 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 15 February 2002 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

***Response to Amendment***

The Amendment, filed on 2/15/2002, has been entered and acknowledged by the Examiner.

Claims 31-59 have been entered.

Claims 1-30 have been canceled.

The Specification has been amended.

The Abstract has been amended.

***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Fluorescent film with luminescent particles.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fastening arrangement (Claim 48), the displacement body with different widths (Claim 49), the interchangeable frame (Claim 50), and the dispensing rollers and take-up rollers (Claim 51) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 31-38 and 40 have been rejected under 35 U.S.C. 102(b) as being anticipated by Lengyel et al. (USPN 5,731,658).

In regard to claim 31, the Lengyel reference discloses a fluorescent film formed from a binding material and phosphor particles (Column 6, Lines 12-20). The binding material is silicon oxide (Column 6, Lines 26-27), a silicone elastomer.

The Examiner notes that the claim limitation of “wherein the film is produced by the following steps: (a) mixing a hydroxyl polydiorganosiloxane with an organohydrogen siloxane, (b) adding luminescent particles; and (c) generating a chemical reaction by means of a platinum catalyst at room temperature“ is drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

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In regard to claim 32, the Examiner notes that the claim limitation of “wherein the hydroxyl polydiorganosiloxane comprises various polymers with a minimum viscosity of 1000 centipoise at 25 degrees Celsius “ further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 33, the Examiner notes that the claim limitation of “wherein the hydroxyl polydiorganosiloxane is formed as at least one of hydroxyl polydimethylsiloxane, its copolymers, phenylmethylsiloxane and polymethyl-3, 3, 3-trifluororopylsiloxane“ further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 34, the Examiner notes that the claim limitation of “wherein the organohydrogen siloxane is formed as silicone with at least two silicon-bonded hydrogen atoms per molecule“ further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the

prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 35, the Examiner notes that the claim limitation of “wherein the organohydrogen siloxane comprises one of homopolymers, copolymers, and mixtures thereof” further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 36, the Examiner notes that the claim limitation of “wherein the platinum catalyst comprises one of a platinum chloride, platinum salts, and chloroplatinic acid” further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 37, the Examiner notes that the claim limitation of “wherein the chloroplatinic acid is in the form of one of a hexahydrate and anhydrous chloroplatinic acid” further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently,

absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 38, the Lengyel reference discloses that the film is on the order of 3 to 5 phosphor particles thick. The particles are in the micron range (Column 1, Lines 50-55). That puts the film in the range of 10 to 800 microns.

In regard to claim 40, the Lengyel reference discloses that the particles are in the micron range, which includes 5 to 15 microns (Column 1, Lines 50-55).

5. Claims 41-42 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwama (JP 404174952A).

In regard to claim 41, the Iwama reference discloses a discharge lamp with an enveloping body (Figure 1, Element 4) that is transparent to UVC (English Abstract) and has electrodes that can be contacted from the outside projecting into the enveloping body (Figure 1, Element 13). There is a color filter made of silicon rubber with zinc oxide particles, which are luminescent (English abstract).

The Examiner notes that the claim limitation of “wherein the film is produced by the following steps: (a) mixing a hydroxyl polydiorganosiloxane with an organohydrogen siloxane, (b) adding luminescent particles; and (c) generating a chemical reaction by means of a platinum catalyst at room temperature. “ is drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 42, the Iwama reference discloses that the film is applied to the outer surface of the enveloping body (Figure 1, Element 17).

In regard to claim 52, the recitation “wherein the fluorescent film is wound around the part of a body to be treated in the manner of a bandage” has not been given patentable weight because it is considered an intended use recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lengyel et al. (USPN 5,731,658).

The limitations of claim 31 are met in the rejection by Lengyel above.

In regard to claim 39, the Lengyel discloses the claimed invention except for the limitation of the surface density of the particles. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use particles with a surface density between 1 and 20 mg/cm<sup>2</sup>, since discovering an optimum value of a result variable is considered within the skills of the art.

***Allowable Subject Matter***

8. Claims 43-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 43, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 43, and specifically comprising the limitation of the fluorescent film having different doping applied to the envelope body.

Regarding claim 44, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 43, and specifically comprising the limitation of a displacement body arranged in the enveloping body so that channels are formed between the enveloping body and the displacement body.

Regarding claims 45-49, claims 45-49 are allowable for the reasons given in claim 44 because of their dependency status from claim 44.

Regarding claim 50, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 41, and specifically comprising the limitation of the film being fitted to the enveloping body in the form of an interchangeable frame.

Regarding claim 51, claim 51 is allowable for the reasons given in claim 50 because of its dependency status from claim 50.

9. Claims 53-59 are allowed.

Regarding claim 53, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 53, and specifically comprising the limitation

of a silicone elastomer with luminescent particles embedded and formed by mixing hydroxyl polydiorganosiloxane with an organohydrogen siloxane, adding luminescent particles, and generating a chemical reaction by means of a platinum catalyst at room temperature.

Regarding claims 54-59, claims 54-59 are allowable for the reasons given in claim 53 because of their dependency status from claim 53.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goldberg et al. (USPN 6,312,782 B1) discloses an elastomer with fluorescent particles.

Beckmann (EP 853112 A1) discloses a silicone rubber with luminescent pigment.

Daisuke (JP 07200599) discloses a rubber elastic material with fluorescent material.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Harper whose telephone number is (703) 305-7908. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

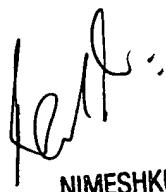
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (703) 305-4794. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Holly Harper  
Patent Examiner  
Art Unit 2879

  
NIMESHKUMAR D. PATEL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800